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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,103

01/20/2004

Sylvie Gauthier

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EXAMINER

TRAN, THAO T

ART UNIT

PAPER NUMBER

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/762,103	<b>Applicant(s)</b> GAUTHIER ET AL.	
	<b>Examiner</b> Thao T. Tran	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 8-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 22-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/16/2007 has been entered.
2. Claims 1-39 are currently pending in this application. Claim 7 has been amended. Claims 34-39 have been newly added.
3. Claims 8-21 have been previously withdrawn as directed to a non-elected invention.
4. In view of the previous Office action, the double patenting rejection and the prior art rejections of the claims are sustained below. In addition, there are new obviousness-type double patenting and prior art rejection of the claims as set forth below.

### *Double Patenting*

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3-6, and 22-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-7, and 9 of Copending Application, Serial No. 10/762,104. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application contain the subject matter that is narrower in scope than that in the instant claims, rendering them obvious over each other.

Claims 1-2, 4-7, and 9 of the copending application recite all of the limitations in instant claims 1, 3-6, and 22-33. Moreover, claims 1 and 6 of the copending application disclose an underlayer and a backer in addition to the core layer and the first decorative layer. Thus, claims 1 and 6 of the copending application are narrower in scope than the instant claims, rendering them obvious over each other.

7. Claims 1-7, 22-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 7,179,538 whether alone, or in view of Lindenfeiser '325 or Albrinck '974, or in view of Hiers et al. (US Pat. 4,132,821). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the patented claims is narrower than that of the instant claims, rendering them obvious over each other.

In regards to instant claims 1-6, claims 1-5 of the patent contain all the limitations in the instant claims. However, the patented independent claims 1, 2, and 3 include the flexible backing layer in addition to the leather layer and the decorative layer of instant claim 1. Thus, the scope of the instant claims embraces that of the patented claims, rendering them obvious over each other.

In regards to claims 7 and 22-33, the patented claims do not specify the resin impregnating the cellulose paper or the weight percent of the resin.

Lindenfeiser discloses a laminate comprising a core sheet impregnated with 33-35% melamine-formaldehyde resin (see col. 2, ln. 15-32). Albrinck discloses a laminate having a core sheet impregnated with 25-35% melamine-formaldehyde resin (see col. 4, ln. 20-25).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the amounts of melamine-formaldehyde resin in the core sheet, as taught by Lindenfeiser or Albrinck, in the laminate of the patented claims, to impart hardness, abrasion and solvent resistance, thus durability to the layer.

In regards to claims 34-39, the patented claims do not specify the leather including animal hide.

Hiers discloses the use of leather containing animal hides (see col. 1, ln. 6-9).

Therefore, it would have been obvious to one of ordinary skill in the art to have employed leather comprising animal hides as taught by Hiers in the laminate of the patented claims, because leather containing animal hides as well as artificial leather have been conventionally used in the art of decorative articles. Moreover, natural leather is more biodegradable and environmentally friendly.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-2, 4-6, 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by McQuade (US Pat. 3,698,978).

McQuade discloses a high pressure laminate comprising core sheets, a decorative print sheets, and overlay sheets. The core sheets are made of paper and impregnated with phenolic resin. The decorative print sheet and the overlay sheets are cellulosic and impregnated with melamine resin. The decorative sheet can be a simulated leather (see Figs 1-2; col. 1, ln. 24-35; col. 2, ln. 36-46; col. 3, ln. 20-50; Examples 1-2; claims 1-2). McQuade further teaches a separator with a siliconized paper, attached to the print sheet (see col. 4, ln. 28-29).

10. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Scher (US Pat. 3,700,537).

Scher discloses a laminate comprising core sheets of kraft paper; a print sheet and an overlay sheet, both made of alpha-cellulose paper. The core sheets are impregnated with a phenol-formaldehyde resin, whereas the print or decorative sheet and the overlay sheet are impregnated with melamine-formaldehyde resin. (See col. 1, ln. 55-71). The print sheet is with decorative printing, and is simulated leather (see col. 2, ln. 20-21), thus meeting the requirements of the presently claimed decorative layer. The thickness of the decorative sheet is greater than 7 mils (greater than 0.18 mm), which meets the requirements of the presently claimed thickness.

***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 7 and 22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over McQuade or Scher in view of Lindenfeiser et al. (US Pat. 2,732,325) or Albrinck et al. (US Pat. 3,589,974).

McQuade and Scher are as set forth in claims 1-6 above and incorporated herein.

Neither McQuade nor Scher discloses the amount of melamine-formaldehyde resin in the core sheet.

Lindenfeiser discloses a laminate comprising a core sheet impregnated with 33-35% melamine-formaldehyde resin (see col. 2, ln. 15-32). Albrinck discloses a laminate having a core sheet impregnated with 25-35% melamine-formaldehyde resin (see col. 4, ln. 20-25).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the amounts of melamine-formaldehyde resin in the core sheet, as taught by Lindenfeiser or Albrinck, in the laminate of McQuade or Scher, to impart hardness, abrasion and solvent resistance, thus durability to the layer.

With respect to the bonded leather, it has been within the skill in the art that bonded leather and simulated leather have been conventionally used as alternative materials. Therefore, it's the examiner's position that it would have been prima facie obvious to substitute one for another and would have given the same results.

13. Claims 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over McQuade or Scher in view of Hiers et al. (US Pat. 4,132,821).

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McQuade and Scher are as set forth in claims 1-6 above and incorporated herein.

Neither McQuade nor Scher discloses the leather to include animal hide.

Hiers discloses the use of leather containing animal hides (see col. 1, ln. 6-9).

Therefore, it would have been obvious to one of ordinary skill in the art to have employed leather comprising animal hides as taught by Hiers in the laminate of McQuade or Scher. The reason is because leather containing animal hides as well as simulated leather have been conventionally used in the art of decorative articles. Moreover, natural leather is more biodegradable and environmentally friendly.

#### ***Response to Arguments***

14. Applicant's arguments filed on 8/16/2006 have been fully considered but they are not persuasive.

The examiner agrees with the applicant that the obviousness-type double patenting rejection, over the claims of the copending application, SN 10/762,104, is held in abeyance pending the disposition of the claims. It is noted that the claims are now also rejected under obviousness-type double patenting over the claims of the US Pat. 7,179,538 above.

In response to the applicant's arguments that neither McQuade nor Scher discloses a first layer consisting of a leather material, but a simulated leather material, the examiner would like to emphasize again that the claim language does not exclude the leather material to be simulated. Thus, McQuade and Scher anticipate the presently claimed invention.

In response to the applicant's argument that none of the references teaches the leather material to be bonded, it is noted that bonded leather and simulated leather have been



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conventionally used as alternative materials. Therefore, it's the examiner's position that it would have been prima facie obvious to substitute one for another and would have yielded the same results.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lindenfeiser and Albrinck are used to illustrate that the claimed weight percents of the melamine formaldehyde resin in the core sheet has been taught in the prior art. Thus, Lindenfeiser and Albrinck are used to remedy McQuade and Scher.

#### ***Contact Information***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thao T. Tran  
Primary Examiner  
Art Unit 1711

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